



UNIVERSITY OF  
MARYLAND  
SCHOOL OF LAW

**PATENT LAW  
UPDATE**

**Jack Guttman,  
Inc.**  
v.  
**Kopykake  
Enters., Inc.**

No. 02-1251  
Federal Circuit  
Aug. 30, 2002

*“District courts may engage in a rolling claim construction, in which the court revisits and alters its interpretation of the claim terms as its understanding of the technology evolves.”*

On August 30, 2002, the Federal Circuit vacated and remanded the district court’s refusal to grant a preliminary injunction against Kopykake for infringing U.S. Patent No. 6,319,530 B1, which relates to a method of copying an image onto an edible substrate sheet that can be placed directly on an iced baked good. The Federal Circuit stated:

The district court based its denial of Guttman’s motion on its construction of the claim terms “photocopy machine” and “non-tortuous copy path”/”tortuous bend.” [T]he court erred in its construction of those terms because it overlooked explicit definitions provided by the patentee in the specification and the prosecution history. Kopykake contends that we should nevertheless affirm, arguing in essence that—notwithstanding the legal error in its claim construction—the trial court acted within its discretion in denying Guttman’s motion. Kopykake’s argument is not without some appeal, for at the preliminary injunction stage we will not lightly intrude upon a district court’s discretionary decision to issue only a tentative claim construction and to base its resolution of a preliminary injunction motion upon that tentative claim construction. . . . District courts may engage in a rolling claim construction, in which the court revisits and alters its interpretation of the claim terms as its understanding of the technology evolves. This is particularly true where issues involved are complex, either due to the nature of the technology or because the meaning of the claims is unclear from the intrinsic evidence. Indeed, these difficulties may be even more acute in the preliminary injunction context than at later stages in the litigation because, as was the case here, motions for a preliminary injunction may come for decision before significant discovery has occurred. Hence, in reviewing a district court’s decision on a motion for a preliminary injunction, we remain “mindful that all findings of fact and conclusions of law at the preliminary injunction stage are subject to change upon the ultimate trial on the merits.”

However, while we are sympathetic to the difficulties that may confront a district court faced with construing highly technical claim language on an expedited basis, we think that in this case, the district court did abuse its discretion in denying Guttman’s motion. [G]rounding a decision on a preliminary injunction on a claim construction at odds with an unambiguous definition in the intrinsic evidence constitutes an abuse of discretion. [T]his is not a case in which the patents “suffer from the malady of ambiguous intrinsic evidence.” [T]he patentee clearly defined the disputed claim terms in the prosecution history and the specification, and we could find no instance in which he used the terms in a fashion inconsistent with those definitions. Nor is this a case involving highly complex technology that required, for example, the consultation of extrinsic evidence to understand the background scientific concepts. And, while discovery had not been completed at the time the district court decided the motion for a preliminary injunction, the court had before it the intrinsic evidence necessary to decide whether the patentee had elected to be his own lexicographer and if so to understand the definitions imposed by the patentee.